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APPLICATION NO. 08/033,172	FILING DATE 04/04/97	FIRST NAMED INVENTOR ROBL	ATTORNEY DOCKET NO. HA680A
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NM11/0807

EXAMINER
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BERCH, M

ART UNIT	PAPER NUMBER
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1611

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DATE MAILED:

08/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/833,172

Applicant(s)

Robl

Examiner

Mark L. B rch

Group Art Unit

1202



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

**Restriction to one of the following inventions is required under 35 U.S.C. 121:**

- I. Claims 1-15, drawn to Benzoxazepinone, classified in class 540, subclass 491.**
- II. Claims 1-15, drawn to Azepinones, classified in class 540, subclass 527.**
- III. Claims 1-15, drawn to Benzazepinones, classified in class 540, subclass 523.**
- IV. Claims 1-15, drawn to Ring System of Ex. 5, classified in class 540, subclass 522.**
- V. Claims 1-15, drawn to Other, classified in class 540, 546, 548, 560, 562, 564, subclass various.**

The inventions are distinct, each from the other because: Each group represents a distinct and structurally different heterocyclic ring system. Group I uniquely has a diverse heteroatom (the oxygen), Group II is uniquely monocyclic; Group IV uniquely has a bridgehead N, and Group V is not limited to 7-membered rings or even to heterocycles. Thus, each group is able to support separate patents.

Because these inventions are distinct for the reasons given above and separate classification restriction for examination purposes as indicated is proper.

During a telephone conversation with Burton Rodney on 10/10/97 a provisional election was made with traverse to prosecute the invention of Group II, claims 1-15. Affirmation of this election must be made by applicant in responding to this Office action. Claims none are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claims 1-15 are rejected as being drawn to an improper Markush Group. The claims are drawn to multiple inventions for reasons set forth in the above requirement for restriction. This does not constitute an art recognized genus. Cancellation of the non-elected subject matter will overcome the rejection.

This can be done by using the first structure of the last line of page 64, setting Y as  $\text{CH}_2$ , and eliminating from the definitions of the variables, the ring forming options for combining  $\text{R}^6\text{-R}^8$ ,  $\text{R}^6\text{-R}^{10}$ , and  $\text{R}^9\text{-R}^{10}$ .

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The term "heteroaryl" is indefinite. Page 11 says, "containing one or two O or S atoms". However, an aromatic ring cannot have two such atoms. The term aryl normally requires that the ring be aromatic, and all the rings named in the paragraph are in fact aromatic. However, the paragraph only says "unsaturated" which is broad enough to cover rings like tetrahydropyridine, which is not aromatic in the normal sense of the term.
2. The term, "cycloheteroalkyl" is indefinite. It is internally contradictory, since a cycloalkyl cannot have a heteroatom.
3. The R definition at Page 60, line 10-12 does not make sense. R is already joined with the Carbon to which it is attached. It can't form a ring without some other unspecified changes. Also, what kind of ring? What other atoms can this ring have? What is the nature of the bonding of the atoms in this ring?

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4. In Claim 13, "effective" for what? The specification gives all sorts of possibilities.
5. "Such as" is improper alternative language (cf.. In re Kingston, 65 USPQ 371).

The abstract is objected to. A definition is needed for R<sup>1</sup>, and the utility needs to be set forth.

Claims 13-14 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for hypertension and CHF, does not reasonably provide enablement for the full scope of "cardiovascular diseases". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. This term is broad enough to cover disorders such as hypotension, arrhythmia, etc, which these compounds obvious cannot treat.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mark Berch whose telephone number is 703-308-4718.



Mark L. Berch

Primary Examiner

Group 120 - Art Unit 1202

December 2, 1997